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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,579	07/12/2001	Carl S. Chow	10007750-I	4263
7590	07/23/2004		EXAMINER	
			WOO, RICHARD SUKYOON	
HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/905,579	CHOW, CARL S.
	<b>Examiner</b> Richard Woo	<b>Art Unit</b> 3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 April 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) 12-18 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 and 7-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Arguments***

- 1) Applicant's amendment filed on April 1, 2004 has been acknowledged.
- 2) Applicant's arguments filed April 1, 2004 have been fully considered but they are not persuasive.

- In response to Applicant's argument that the Claims 1 and 7 including: calculating postage for a booklet is within the technological arts, the examiner respectfully traverses to this. The examiner submits again that the applicant revisit the pertinent 35 U.S.C. 101 rejection in the prior office action and additionally, invites the applicant's attention to the following Definition of Class 705 unless the applicant does not wish to follow the Classification system and to comply with its definition as suggested by the U.S. Patent and Trademark Office as follows:

"This is the generic class for apparatus and corresponding methods for performing data processing operations, in which there is a **significant change in the data** or for performing calculation operations wherein the apparatus or method is uniquely designed for or utilized in the practice, administration, or management of an enterprise, or in the processing of financial data." See Classification Definitions.

In the instant application, Claims 1 and 7 are directed to the method including calculating postage for the booklet based on the total weight of the booklet. The recited steps including calculating may be performed by a mere human intervention (i.e., a person can count the number of sheets, estimate the weight, multiply the number of sheets by the estimated weight to calculate the total weight and ultimately calculate

postage for the booklet based on the total weight by looking up the postage chart for example (this traditional business practice has been around for years before the applicant's invention). The burden has been shifted to the applicant to prove that the applicant is the first one to conceive these recited steps that can be performed without computer manipulations.

- Applicant's argument that Tonkin does not disclose the method including calculating postage for the booklet based on the total weight has been fully considered and is persuasive. The previous rejections under 35 U.S.C. 102 have been withdrawn.

***Claim Rejections - 35 USC § 101***

- 3) 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 4) Claims 1-3 and 7-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Please see the pertinent section in Response to Arguments and the previous office action.

***Claim Rejections - 35 USC § 103***

- 5) Claims 1-3 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonkin (US 6,134,568) in view of EP 0621563 A1 (hereinafter EP).

As for Claim 1, Tonkin discloses a method comprising:

counting the number of sheets of media in the booklet (col. 9, line 52 – col. 10, line 3);

estimating the weight of each sheet of media (*Id.*); and  
multiplying the number of sheets of media in the booklet by the estimated weight of each sheet of media to calculate the total weight of the booklet (see Fig. 9; generally cols. 9-10).

However, Tonkin does not specifically disclose the method further including the step of calculating postage for the booklet based on the total weight of the booklet.

EP teaches, for system and method for preparing items for mailing, that the system calculates the postage and prints it on the booklet, wherein the postage amount is calculated by the total weight of selected items with known weights (col. 5, lines 43-56).

Since EP and Tonkin are both from the same field of endeavor of printing items with known weight and combining the items to calculate the total weight, the purpose disclosed by EP would have been well recognized in the pertinent field of Tonkin.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to calculate the exact postage for the booklet of Tonkin based on the total weight of the booklet, as taught by EP, for the purpose of charging proper postage may be applied to the corresponding booklet.

As for Claim 2, the modified method of Tonkin further discloses the method, wherein the booklet includes binding materials, the method further including:

estimating the weight of the binding materials (col. 8, line 49, - col. 10, line 3 in Tonkin; and see Figs. 5A-9 of Tonkin); and

adding the weight of the binding materials and the total weight of the booklet (*Id.*).

As for Claim 3, the modified method of Tonkin further discloses the method including:

estimating the weight of the cover (col. 8, line 49, - col. 10, line 3 in Tonkin; see Figs. 5A-9 of Tonkin); and

adding the weight of the cover and the total weight of the booklet (*Id.*).

As for Claim 7, Tonkin discloses a method comprising:  
calculating the weight of the booklet by multiplying the number of sheets of media which are used in the booklet by the estimated weight of each sheet of media (col. 8, line 49, - col. 10, line 3; see Figs. 5A-9).

However, Tonkin does not expressly disclose the method further including the step of calculating postage for the booklet based on the total weight of the booklet.

EP teaches, for system and method for preparing items for mailing, that the system calculates the postage and prints it on the booklet, wherein the postage amount

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is calculated by the total weight of selected items with known weights (col. 5, lines 43-56).

Since EP and Tonkin are both from the same field of endeavor of printing items with known weight and combining the items to calculate the total weight, the purpose disclosed by EP would have been well recognized in the pertinent field of Tonkin.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to calculate the exact postage for the booklet of Tonkin based on the total weight of the booklet, as taught by EP, for the purpose of charging proper postage may be applied to the corresponding booklet.

As for Claim8, the modified method of Tonkin further discloses the method comprising:

receiving a client inquiry (see Figs. 5A-9 and the descriptions thereof in Tonkin);  
prompting the client for a name and address in response to the client inquiry (*Id.*);  
receiving a name and address from the client in response to the prompt (*Id.*);  
sending a literature selection prompt signal to the client via the communication link in response to receiving the name and address data signal (see *Supra* Figs.);  
receiving a literature selection data signal from the client via the communication link in response to receiving the selection data signal (see Figs. 5A-9 and the descriptions thereof);  
sending a finish command prompt signal to the client (*Id.*); and

receiving a finish command signal from the client and wherein the weight of the booklet is calculated in response to receiving the finish command signal (col. 8, line 49, - col. 10, line 3; see Figs. 5A-9 of Tonkin).

As for Claim 9, the modified method of Tonkin further discloses the method including:

assembling selected literature in response to the receiving the finish command signal (col. 8, line 49, - col. 10, line 3; see Figs. 5A-9 of Tonkin); and

printing the selected literature onto sheets of media in response to assembling the selected literature (*Id.*)

As for Claim 10, the modified method of Tonkin further discloses the method including:

storing a name and address of a client in a memory in response to receiving the name and address data signal (see Figs. 1-3 and descriptions thereof Tonkin);

retrieving the name and address of the client from the memory in response to receiving the finish command signal; and

printing the name and address of the client on a cover sheet of media in response to retrieving the name and address data (EP teaches the system and method that prints the name and address as well as postage on the publication).

As for Claim 11, the modified method of Tonkin further discloses the method including:

generating a customized cover letter addressed to a client based on literature selected by the client and in response to receiving the finish command signal (see the document summary in Fig. 9 of Tonkin); and

printing the cover letter on a sheet of media which is to be included in the booklet in response to generating the customized cover letter (see Fig. 9 and col. 13, line 52 – col. 14, line 59).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

  
Richard Woo  
Patent Examiner  
GAU 3629  
July 1, 2004

  
DEANT. NGUYEN  
PRIMARY EXAMINER  
7/21/04